UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,770	09/11/2000	Frank J. McConnell	SACO115537	4422

26389   7590   11/01/2004

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ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

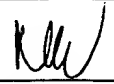|		Application No.	Applicant(s)
Office Action Summary		09/658,770	MCCONNELL ET AL.
		Examiner	Art Unit
		Natalie A. Pass	3626

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8 and 10-19* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8 and 10-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submissions filed on 16 August 2004 have been entered.

2.   This communication is in response to the Request for Withdrawal of Appeal, the Request

for Continued Examination and the response filed 16 August 2004. Claims 1, 3-6, 8, 10, 14, 19

have been previously presented. Claims 2 and 9 have been previously cancelled. Claims 1, 3-8,

10-19 remain pending.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1, 3, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham,

U.S. Patent Number 5, 537, 315 for substantially the same reasons given in the previous Office

Action (paper number 12). Further reasons appear hereinbelow.

(A)   As per claims 1, 3, Mitcham teaches a method for providing an insurance policy

via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36,

column 3, lines 30-61), comprising:

receiving a request for a bindable premium quotation for an insurance policy (Mitcham;

see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines

1-4, 52-65, column 6, lines 53-60);

gathering underwriting information from one or more outside information resources

based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determining whether said insurance policy may be underwritten (Mitcham; Figure 3G,

column 8, lines 1-23);

in response to determining that said insurance policy may be underwritten, calculating a

premium for said insurance policy and providing said premium to a requestor of said premium

quotation as a bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure

14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47);

receiving a request to purchase said insurance policy according to said bindable insurance

premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column

4, lines 22-25); and

in response to said request, re-intermediating an insurance agent and issuing said

insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2, lines 9-14,

column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line 20 to column

10, line 8);

wherein issuing said insurance policy comprises transmitting an electronic version of said

insurance policy, or issuing the policy on-the-spot, to an individual insured by said insurance

policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32).

(B)   As per claim 19, Mitcham teaches a computer-readable medium containing

computer-executable instructions which, when executed by a computer, cause the computer to

perform the method of Claims 1, 3 (Mitcham; see at least Figure 1 column 3, lines 30-61).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 4-8, 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mitcham, U.S. Patent Number 5, 537, 315 in view of CNA Customer Services State Sales

Offices website, hereinafter known as CNA, URL:

<http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_state.html>, and

further in view of MostChoice Advisor website, hereinafter known as MostChoice, URL:

<http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/

Why/G_Adv_Why_Overview.cfm> for substantially the same reasons given in the previous

Office Action (paper number 12). Further reasons appear hereinbelow.

(A)   As per claims 4-7, Mitcham teaches a method as analyzed and discussed in claim

1 above.

Mitcham fails to explicitly disclose a method wherein re-intermediating an insurance

agent comprises:

providing a list of available insurance agents, including providing a list of available

insurance agents, said available insurance agents identified based upon their geographical

proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said

selected or assigned insurance agent; and

remitting a commission to said selected or assigned insurance agent;

wherein said assigned insurance agent comprises the geographically closest available

insurance agent to said customer.

CNA teaches a method wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, including providing a list of available

insurance agents, said available insurance agents identified based upon their geographical

proximity to said individual (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents by

fax or e-mail or phone (CNA; pages 1-10); and

transmitting information regarding said individual and said insurance policy to said selected insurance agent by fax or e-mail or phone (CNA; pages 1-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method for providing an insurance policy via a distributed computing network of Mitcham to include wherein re-intermediating an insurance agent comprises providing a list of available insurance agents, including providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual, receiving the selection of a selected agent from the list of available insurance agents and transmitting information regarding said individual and said insurance policy to said selected insurance agent, as taught by CNA, with the motivation of assisting and enabling customers to find the and utilize the information they need when purchasing insurance (CNA; pages 13, 16).

Mitcham and CNA do not explicitly disclose

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

remitting a commission to said selected or assigned insurance agent;

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

MostChoice teaches

assigning said selected insurance agent to said insurance policy including

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said assigned insurance agent (MostChoice; see at least page 6); and

remitting a commission to said assigned insurance agent(MostChoice; see at least page 8);

wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer (MostChoice; see at least pages 1-4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Mitcham and CNA to include assigning said selected insurance agent to said insurance policy and remitting a commission to said selected insurance agent wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer, as taught by MostChoice, with the motivation of educating and empowering potential customers to purchase insurance by connecting them with certified local advisors who are knowledgeable experts, don't let customers "fall through the cracks," are always available to answer questions, and can help customers get what they want without any pressure, and to entice the best agents (MostChoice; pages 1, 6, 8, 10).

(B)   Claim 8 differs from claim 1 in that it is a system for providing an insurance policy via a distributed computing network rather than a method for providing an insurance policy via a distributed computing network.

As per claim 8, Mitcham, CNA and MostChoice teach a system for providing an insurance policy via a distributed computing network (Mitcham; see at least Figure 1, Items 22, 30, 32, 34, 36, column 3, lines 30-61), comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network (CNA; pages 1-19), (MostChoice; pages 1-9) , and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 12, Figure 13, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60);

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request (Mitcham; Figure 3G, column 7, lines 54-64), (MostChoice; pages 1-5);

gather underwriting information from one or more outside information resources based upon the identify of said individual (Mitcham; Figure 3G, column 7, lines 54-64);

determine whether said insurance policy may be underwritten (Mitcham; Figure 3G, column 8, lines 1-23), (MostChoice; page 3);

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 14-16, column 7, lines 51-65, column 8, lines 37-47), (CNA; pages 18-19), (MostChoice; pages 1-3, 8, 10);

receive a request to purchase said insurance policy according to said bindable insurance

premium quotation (Mitcham; see at least Figure 13, Figure 14A, column 2, lines 2-15, column

4, lines 22-25);

re-intermediate and insurance agent (Mitcham; Figure 13, lines 32-34, column 1, lines

64-67, column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36,

column 9, line 20 to column 10, line 8); and

issue said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67,

column 2, lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36,

column 9, line 20 to column 10, line 8).

The motivations for combining the respective teachings of Mitcham, CNA and

MostChoice are as given in the rejection of claims 1 and 4 above, and incorporated herein.

(C)   As per claims 10-13, Mitcham, CNA and MostChoice teach a system as discussed

and analyzed in claim 8 above wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy (MostChoice;

see at least pages 1-4, 6, 8, 12);

wherein said interactive help system comprises an interactive chat facility or Advisor

Connect service for providing real-time communication between said requestor of said insurance

policy and an insurance help-desk representative (MostChoice; see at least pages 1-4, 6, 8, 11);

wherein said interactive help system further comprises an e-mail facility for receiving an

electronic mail message from said requestor of said insurance policy and transmitting said

message to an insurance help-desk representative (CNA; pages 1-10), (MostChoice; see at least

pages 1-4, 6, 8, 12); and

wherein said interactive help system further comprises a facility for notifying an

insurance help-desk representative that said requestor of said insurance policy would like to

receive a telephone call providing assistance (MostChoice; see at least pages 1-4, 6, 8, 11).

(D)   As per claims 14-15, Mitcham, CNA and MostChoice teach a system as discussed

and analyzed in claim 8 above wherein issuing said insurance policy comprises transmitting an

electronic version of said insurance policy, or issuing the policy on-the-spot, to an individual

insured by said insurance policy (Mitcham; Figure 4, column 3, line 61 to column 4, line 32)

and wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents

(CNA; pages 1-10);

assigning said selected insurance agent to said insurance policy (MostChoice; see at least

pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said

selected insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice; see at least

page 6); and

remitting a commission to said selected insurance agent (MostChoice; see at least page

8).

(E)   As per claims 16-18, Mitcham, CNA and MostChoice teach a system as discussed

and analyzed in claims 8 and 14 above wherein re-intermediating an insurance agent comprises:

provicing a list of available insurance agents, said available insurance agents identified

based upon their geographical proximity to said individual (CNA; pages 1-10);

receiving the selection of a selected agent from the list of available insurance agents by

fax or e-mail or phone (CNA; pages 1-10);

assigning said selected insurance agent to said insurance policy, including

assigning an insurance agent to said insurance policy based upon the geographical

proximity of said insurance agent to said individual; (MostChoice; see at least pages 1, 3, 10);

transmitting information regarding said individual and said insurance policy to said

selected or assigned insurance agent by fax or e-mail or phone (CNA; pages 1-10), (MostChoice;

see at least page 6); and

remitting a commission to said selected or assigned insurance agent (MostChoice; see at

least page 8);

wherein said assigned insurance agent comprises the geographically closest available

insurance agent to said customer (MostChoice; see at least pages 1, 3, 10).

(F)   As per claim 19, Mitcham, CNA and MostChoice teach a computer-readable

medium containing computer-executable instructions which, when executed by a computer,

cause the computer to perform the method of Claims 4-7 (Mitcham; see at least Figure 1 column

3, lines 30-61).

Response to Arguments

7.   Applicant's arguments filed 16 August 2004 have been fully considered but they are not

persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they

appear in the response filed 16 August 2004.

(A)   At pages 10-13 of the 16 August 2004 response, Applicant analyzes the applied

references separately and argues each of the references individually. In response to Applicant's

arguments against the references individually, one cannot show nonobviousness by attacking

references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed Cir. 1986).   In addition, the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary reference; nor

is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those

of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(B)   At page12-13 of the 16 August 2004 response, Applicant argues that the reference

cited from an archived website is not an enabling reference. The MostChoice website, consisting

of a plethora of linked web pages, 12 of which are used as references, was actively maintained

during the period cited, and recites the claimed elements as analyzed and discussed in the prior

Office Action (paper number 12) and in the current Office Action. As is well known in the art,

archived web pages are frequently not maintained to the present day. Many archived websites

are, in fact, actively disabled by site owners using software known as robots. Nevertheless, the

discovery by Applicant of one web page listed as "Under Construction" today neither proves nor

disproves the enablement of these web pages at the time the claimed invention was made.

Furthermore, it has been established that "[e]ven if a reference discloses an inoperative device, it

is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547,

1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may

qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol*

Techs. Inc. v. Opticon Inc., 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991).

(C)   At pages 13-21 of the 16 August 2004 response, Applicant argues that the

limitations of Applicant's invention are not taught or suggested by the applied reference and that

a *prima facie* case of anticipation has not been established. Examiner respectfully disagrees.

In response, all of the limitations which Applicant disputes are missing in the applied

reference, have been fully addressed by the Examiner as either being fully disclosed or obvious

in view of the teachings of Mitcham, based on the logic and sound scientific reasoning of one

ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 102 and 35

USC § 103 rejections given in the preceding sections of the present Office Action and in the

prior Office Action (paper number 12), and incorporated herein. In particular, Examiner notes

that Mitcham teaches re-intermediating the insurance agent following the receipt of a request to

purchase an insurance policy. Note, for example, that Mitcham teaches a system where, in one

embodiment, "[t]he options may include completing an application, having a representative of

the company contact the user, printing a quote of the selected level of coverage, or exiting the

program" (Mitcham; column 6, lines 20-24) (emphasis added). Please note that Examiner

interprets this passage as including Applicant's limitation of "in response to said request, re-

intermediating an insurance agent." Further, Mitcham teaches that it is known in the insurance

industry for a representative or agent of an insurance company to create an insurance agreement

or policy based on information obtained from a prospective insured and that an insurance rate is

calculated based on the information the prospective insured provides, in addition to the level of

coverage the individual desires (Mitcham; column 1, lines 64 to column 2, line 2) and as well,

Mitcham advises, in Figure 13, that "no sales call will be made without your request. To

purchase your policy, please contact [...insurance agency or agent...] at [...recited phone

number...]" (emphasis added), thus teaching re-intermediating the agent upon receiving a

request to purchase a policy. The Examiner interprets this to mean that Mitcham allows the

purchase of a policy in either embodiment, either without or with the re-intermediation of an

insurance agent. The Examiner therefore has correctly established a *prima facie* case of

anticipation.

    (D)   At pages 13- 14 of the 16 August 2004 response, Applicant apparently argues that

a *prima facie* case of obviousness has not been established.

    In response, the Examiner respectfully submits that obviousness is determined on the

basis of the evidence as a whole and the relative persuasiveness of the arguments. See In *re*

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In *re Hedges,* 783 F.2d

1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); In *re Piasecki,* 745 F.2d 1468, 1472, 223

USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147

(CCPA 1976).

In response to Applicant's argument that there is no suggestion to combine the references,

the Examiner recognizes that obviousness can only be established by combining or modifying

the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Mitcham's method and system for providing an insurance policy

via a distributed computing network (Mitcham; column 3, line 62 to column 4, line 3) in which

the insurance agent or representative is re-intermediated following the receipt of a request to

purchase an insurance policy (Mitcham; Figure 13, column 1, lines 64 to column 2, line 2,

column 6, lines 20-24) to include the CNA reference, which includes providing a list of available

insurance agents, said available insurance agents identified based upon their geographical

proximity to said individual, receiving the selection of a selected agent from the list of available

insurance agents and transmitting information regarding said individual and said insurance

policy to said selected insurance agent, (CNA; pages 1-10) with the motivation of assisting and

enabling customers to find the and utilize the information they need when purchasing insurance

(CNA; pages 13, 16). And it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the collective teachings of Mitcham and CNA to include

the MostChoice reference, which includes assigning said selected insurance agent to said

insurance policy and remitting a commission to said selected insurance agent wherein said

assigned insurance agent comprises the geographically closest available insurance agent to said

customer (MostChoice; pages 1-12), with the motivation of educating and empowering potential

customers to purchase insurance by connecting them with certified local advisors who are

knowledgeable experts, don't let customers "fall through the cracks," are always available to

answer questions, and can help customers get what they want without any pressure, and to entice

the best agents (MostChoice; pages 1, 6, 8, 10).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or

modified and that there must be some reason why one skilled in the art would be motivated to

make the proposed modifications. And although the motivation or suggestion to make

modifications must be articulated, it is respectfully submitted that there is no requirement that the

motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their

specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

However, in the instant case, the Examiner respectfully notes that each and every

motivation to combine the applied references is accompanied by select portions of the respective

reference(s) which specifically support that particular motivation (see paper number 12). As

such, it is NOT seen that the Examiner's combination of references is unsupported by the applied

prior art of record. Rather, it is respectfully submitted that explanation based on the logic and

scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons indicated

by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93). Using

this standard, the Examiner respectfully submits that the burden of presenting a *prima facie*

case of obviousness has at least been satisfied, since evidence has been presented of

corresponding claim elements in the prior art and the combinations and the motivations for

combinations that fairly suggest Applicant's claimed invention have been expressly articulated.

(E)   At the paragraph bridging pages 13- 14 of the 16 August 2004 response,

Applicant argues that the applied references fail to teach "[o]nce an agent has been selected,

complete control of a customer's account is transferred... to the selected agent". Examiner

respectfully notes that this limitation has not been recited.

(F)   At pages 14-18 of the 16 August 2004 response, Applicant argues that Examiner's

analysis of the Mitcham reference is incorrect. Examiner respectfully disagrees with Applicant 's

interpretation of the Mitcham reference.

In response to Applicant 's analysis of Figures 3C-3G of the Mitcham reference at pages

14-18 of the 16 August 2004 response, Examiner notes, as explained in paper number 12, that

throughout the figures of Mitcham, it is Item E (also referred to as block 274), as shown in

Mitcham, (see at least Figure 3F) and not Item H, which represents exiting Mitcham's program

(also please see at least Mitcham; column 8, lines 57-61). Examiner notes that Block 280 of

Figure 3F very clearly shows that Mitcham's invention uses the symbol "E" for Exit by placing

the letter "E" in the flow chart as the destination when the "user select[s] 'EXIT.'" Hence the

option for a representative of an insurance company to contact the user does NOT occur "well

after the completion of the insurance contract," as alleged by Applicant, but rather as an integral part of Mitcham's invention. See, for example, column 6, lines 19-24 of Mitcham, which states "[n]ext, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program [emphasis added]." These options are further pictured in the flow chart of Figure 3D of Mitcham, which is detailed in column 8, lines 24-36. Additionally, as noted in the applied Figure 13, lines 32-34, Mitcham provides the customer with the ability to re-intermediate an insurance agent by stating "to purchase your policy, please contact AUTOSURE at (214) 325-3001."

Furthermore, regarding Applicant's assertion in the paragraph bridging pages 17-18 and the following paragraph that the Mitcham reference only offers only one choice to the customer because the word "or" is present, Examiner respectfully disagrees. Nothing in the language of Mitcham precludes selecting more than one option. Additionally, this aspect of Mitcham is very clearly shown in Figure 3C, Items 248 and 249, and Figure 3D, Items 249 to 274. According to Mitcham's flow chart, if user does NOT select "'EXIT" (Item 326) all options remain available.

Thus, Examiner respectfully reasserts that the system of Mitcham does teach the limitations of claims 1 that are argued by Applicant, including receiving a request for a bindable premium quotation for an insurance policy (Mitcham; see at least Figures 3A -3G, Figure 4, Figure 13, Figure 14A, column 2, lines 2-15, column 4, lines 9-31, column 5, lines 1-4, 52-65, column 6, lines 53-60) and in response to said request, re-intermediating an insurance agent and issuing said insurance policy (Mitcham; Figure 13, lines 32-34, column 1, lines 64-67, column 2,

lines 9-14, column 4, lines 16-17, column 6, lines 19-24, column 8, lines 31-36, column 9, line

20 to column 10, line 8).

With regard to Applicant's allegation on pages 18-19 of the 16 August 2004 response,

that Mitcham's teaching of an "informational quotation only" fails to teach the limitations of

Applicant's claim 1, Examiner interprets the teachings of a published document (as shown in

Mitcham's Figure 13) offering an "informational quotation" and also offering notification that

"[c]hanges in coverage will affect this proposal and premium amounts quoted" and further

including instructions on how to purchase the policy by phoning (reads on re-intermediating) an

agent, reads on the limitations of claim 1.

Furthermore, in response to Applicant's question on page 19 of the 16 August 2004

response as to why the "the above-cited portion of Mitcham was not originally revealed in full,"

Examiner notes that re-intermediating is further taught in Mitcham's column 6, lines 19-21,

which states (as noted above) "[n]ext, the process passes to block 248 which illustrates the

displaying of options. The options may include completing an application, having a

representative of the company contact the user [which would clearly be in response to the request

of the user], printing a quote of the selected level of coverage, or exiting the program [emphasis

added]." These options are further pictured in the flow chart of Figure 3D of Mitcham, which is

detailed in column 8, lines 24-36, and which has been discussed above and in the prior Office

Action (paper number 12).

With regard to Applicant's statement on page 19, line 16 of the 16 August 2004 response

that "[n]o bindable insurance premium quotation is provided by Mitcham at FIGURE 13"

Examiner understands a bindable insurance premium quotation, as defined in Applicant's

specification on page 7, lines 3-5, to be "a quotation of a premium for an insurance policy that

may be purchased immediately by the customer". As such, the bindable quotation has not yet

been purchased but it may be purchased, as noted in the cited lines described above, and

displayed in Figure 13 of Mitcham. In the case of Mitcham, it is Examiner's interpretation that if

Mitcham were publishing rates that were not purchasable or bindable (and which included the

advice "[c]hanges in coverage will affect this proposal and premium amounts quoted") then the

information published in Figure 13 would represent a fraudulent offering. Therefore it is

Examiner's interpretation that Mitcham does provide a bindable insurance quotation, in that

Mitcham's insurance quotation is one that is capable of binding the insurance company to the

quotation.

With regard to Applicant's assertion in the last paragraph on page 20 of the August 2004

response that "[t]he Examiner argues that the reference...need not teach every element of the

claimed invention ..." Examiner respectfully disagrees, as this affirmation was never put forth by

this Examiner. Further, with regard to Applicant's reference to the quotation cited in *Richardson*

v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989): "The

identical invention must be shown in as complete detail as is contained in the ... claim, (emphasis

added)," Examiner notes that MPEP § 2131 states that "TO ANTICIPATE A CLAIM, THE

REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM (emphasis added)" and

that "[a] claim is anticipated only if each and every element as set forth in the claim (emphasis

added) is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir.1987). With this noted, Examiner points out that each and every element <u>as set forth in the</u>

<u>claims</u> has been found in the Mitcham reference.

As such, it is unclear as to how or why Applicant's <u>claimed limitations</u> are not met by at

least the aforementioned passages. Perhaps Applicant is relying on features not expressly recited

in the claims, but disclosed in the specification. However it has been held that although the

claims are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly Examiner disagrees with Applicant's contention to the contrary and asserts

that a *prima facie* case of anticipation has indeed been established and the applied Mitcham

reference does teach Applicant's claimed limitations of claims 1, 3, and 19. (Examiner

respectfully notes that limitations of claim 8 are taught by the combination of Mitcham, CNA,

and MostChoice references, and not by the Mitcham reference alone, as mentioned in lines 12-13

on page 21 of the 16 August 2004 response.)

With regard to Applicant's assertion on pages 21-22 of the 16 August 2004 response that

the applied references fail to teach the limitations "as recited in Claims 1, 8, and 19," Examiner

respectfully notes that the Applicant analyzes the applied references separately and argues each

of the references individually, applying references to limitations to which they were not applied.

In fact, the CNA reference teaches a method wherein re-intermediating an insurance agent

comprises providing a list of available insurance agents, including providing a list of available

insurance agents, said available insurance agents identified based upon their geographical

proximity to said individual (CNA; pages 1-10); receiving the selection of a selected agent from

the list of available insurance agents by fax or e-mail or phone (CNA; pages 1-10); transmitting

information regarding said individual and said insurance policy to said selected insurance agent

by fax or e-mail or phone (CNA; pages 1-10). Additionally, the MostChoice reference was

brought in to disclose the limitations of claims 4-7, specifically assigning said selected insurance

agent to said insurance policy including assigning an insurance agent to said insurance policy

based upon the geographical proximity of said insurance agent to said individual; (MostChoice;

see at least pages 1, 3, 10); transmitting information regarding said individual and said insurance

policy to said assigned insurance agent (MostChoice; see at least page 6); and remitting a

commission to said assigned insurance agent(MostChoice; see at least page 8) wherein said

assigned insurance agent comprises the geographically closest available insurance agent to said

customer (MostChoice; see at least pages 1-4).

(G)   At pages 22-27 of the 16 August 2004 response, Applicant argues that the applied

art fails to teach re-intermediation of an insurance agent upon receiving a request to purchase an

insurance policy...made via a distributed computing network. Examiner respectfully disagrees

with Applicant 's interpretation of the applied references.

In particular, Examiner notes that Mitcham teaches re-intermediating the insurance agent

following the receipt of a request to purchase an insurance policy. Note, for example, that

Mitcham teaches a system where, in one embodiment, "[t]he options may include completing an

application, having a representative of the company contact the user, printing a quote of the

selected level of coverage, or exiting the program" (Mitcham; column 6, lines 20-24) (emphasis

added). Please note that Examiner interprets this passage as including Applicant's limitation of

"in response to said request, re-intermediating an insurance agent." Further, Mitcham teaches that

it is known in the insurance industry for a representative or agent of an insurance company to

create an insurance agreement or policy based on information obtained from a prospective

insured and that an insurance rate is calculated based on the information the prospective insured

provides, in addition to the level of coverage the individual desires (Mitcham; column 1, lines 64

to column 2, line 2) and as well, Mitcham advises, in Figure 13, that "no sales call will be made

without your request. To purchase your policy, please contact [...insurance agency or agent...] at

[...recited phone number...]" (emphasis added), thus teaching re-intermediating the agent upon

receiving a request to purchase a policy. The Examiner interprets this to mean that Mitcham

allows the purchase of a policy in either embodiment, either without or with the re-

intermediation of an insurance agent. In addition, Mitcham's invention takes place over a

distributed computing network (column 3, lines 52-60). Furthermore, the MostChoice reference

offers multiple embodiments, i.e. "... a local advisor makes a lot of sense," (reads on re-

intermediation of an insurance agent) as well as "... you don't have to use an advisor ...," as

well as "[y]ou can apply online [reads on over a distributed computing network] with us and

barely talk to anyone at all during the process."

(H)   At page 25 of the 16 August 2004 response, Applicant takes exception to

Examiner's application of Mitcham, column 9, line 20 to column 10, line 8 to the limitation in

claim 1, and argues that this citation fails to teach re-intermediation of an insurance agent upon

receiving a request to purchase an insurance policy. Examiner respectfully notes that this

citation was applied to teach the limitation of issuing said insurance policy and not re-

intermediation of an insurance agent.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of

the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the

mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed,

and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory

action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the

date of this final action.

9.   **Any response to this final action should be mailed to:**

Box AF

    Commissioner of Patents and Trademarks
    Washington D.C. 20231

or faxed to:
    (703) 305-7687.

    For formal communications, please mark
    "EXPEDITED PROCEDURE".

    For informal or draft communications, please label
    "PROPOSED" or "DRAFT" on the front page of the
    communication and do NOT sign the communication.

    Hand-delivered responses should be brought to Crystal Park 5,
    2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The

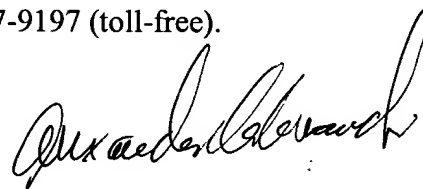examiner can also be reached on alternate Fridays.

11.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature

or relating to the status of this application or proceeding should be directed to the Receptionist

whose telephone number is (703) 308-1113.

12.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

October 27, 2004

ALEXANDER KALINOWSKI
PRIMARY EXAMINER